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OFFICE OF PETITIONS

In re Patent No. 7,757,066 :
Jarvis et al. :
Application No. 09/751,372 : LETTER REGARDING
Issue Date: July 13, 2010 : PATENT TERM ADJUSTMENT
Filed: December 29, 2000 :
Atty Docket No. 00-BN-51 :
(STMI01-00051) :

This decision is in response to the "REQUEST FOR RECONSIDERATION OF DECISION ON REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT AND NOTICE OF INTENT TO ISSUE CERTIFICATE OF CORRECTION," filed November 4, 2010, requesting that the patent term adjustment determination for the above-identified patent be changed from one thousand, seven hundred and fifty-nine (1759) days to two thousand, seven hundred and twenty-two (2722) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by two thousand, seven hundred and twenty-two (2722) days is **DISMISSED**.

BACKGROUND

On July 13, 2010, the above-identified application matured into US Patent No. 7,757,066 with a patent term adjustment of 2644 days. A request for reconsideration of patent term adjustment was timely filed within two months of the issue date of the patent on July 21, 2010, and the petition was granted via the mailing of a decision on October 4, 2010, to the extent that the decision indicated that the patent term adjustment would be extended by one thousand, seven hundred and fifty-nine (1759) days. The decision of October 4, 2010 set a non-extendable one month period for reply, and as such, this filing of November 4, 2010 is timely filed.

The record supports a conclusion that this patent is not subject to a terminal disclaimer.

With the decision of October 4, 2010, Patentee was accorded 321 (2388 over three years - 1104 that are excluded due to appellate review - 963 overlap) days of B-delay. Patentee maintains entitlement to a period of adjustment due to the Three Year Delay by the Office, pursuant to 37 CFR § 1.703(b), of 1284 (2388 - 1104). In other words, Patentee argues that the 963 days of overlap should not be deducted from the B-delay, as they fall on the same calendar days as one of two excluded appellate periods.

OPINION

As set forth in the decision of October 4, 2010, a first notice of appeal was filed on August 26, 2004, and a non-final office action was mailed on January 13, 2005. The 141 days of the over three year period consumed by appellate review, beginning on August 26, 2004 and ending on January 13, 2005, are not included in the B delay. See 35 U.S.C. § 154(b)(1)(B)(ii). A second notice of appeal was filed on April 2, 2007, and a Decision on Appeal was mailed on November 19, 2009. The 963 days of the over three year period consumed by appellate review, beginning on April 2, 2007 and ending on November 19, 2009, are not included in the B delay. See 35 U.S.C. § 154(b)(1)(B)(ii). It follows that the period of exclusion which is deducted from the B-delay totals 1104 (141 + 963) days.

The aforementioned notice of appeal was filed on April 2, 2007, and a Decision on Appeal was mailed on November 19, 2009, reversing the Examiner. This constitutes 963 days of examination delay, pursuant to 37 C.F.R. § 1.703(e).

Patentee argues that the Office should not deduct the 963-day period of overlap, as the entire period of overlap occurs on the same calendar days as the 963-day excluded period.¹

Patentee's argument has been considered, but not found persuasive. The Office holds that the 1104-day period comprised of the 141-day period from August 26, 2004 to January 13, 2005 and the 963-day period from April 2, 2007 to November 19, 2009, and this 1104-day period is excluded from the period of B-delay,

¹ Petition, pages 2-3.

and the 963-day period of A-delay from April 2, 2007 to November 19, 2009 overlaps with the period of B-delay. The Office further holds that it is proper to reduce the period of B delay by both the entire 963-day excluded period and the entire period of overlap, despite the fact that 963 days of the 963-day excluded period fall on the same calendar days as the overlapping period.

Conclusion

In view thereof, no adjustment to the patent term will be made. It follows that a certificate of correction is not required.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. § 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. § 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3225.²

It is noted that the address listed on the petition differs from the address of record. The application file does not indicate a change of correspondence address has been filed in this case, although the address given on the petition differs from the address of record. If Petitioner desires to receive future correspondence regarding this patent, the change of correspondence address must be submitted. A courtesy copy of this decision will be mailed to the address which appears on the petition. However, all future correspondence will be directed to the address of record until such time as appropriate instructions are received to the contrary. Petitioner will not receive future correspondence related to this patent unless Change of Correspondence Address, Patent Form (PTO/SB/123) is submitted for the above-identified patent. For Petitioner's convenience, a blank Change of Correspondence Address, Patent

² Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.

Form (PTO/SB/123), may be found at
<http://www.uspto.gov/web/forms/sb0123.pdf>.

If appropriate, a change of fee address (form PTO/SB/47) and a request for customer number (form PTO/SB/125) should be filed in accordance with Manual of Patent Examining Procedure, section 2540.

A blank fee address form may be found at
<http://www.uspto.gov/web/forms/sb0047.pdf>.

/Paul Shanoski/
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